

Application No.: 10/669,403
Docket No.: UC0315USNA

REMARKS

The following remarks are responsive to the Examiner's rejection in the Office Action dated April 1, 2008.

Status of the claims

The pending claims are 15 and 22-32. Claims 15 and 22-32 stand rejected.

Amendments to the Claims

Claims 15, 22 and 23 are amended to advance the prosecution by more particularly reciting the active material in the liquid composition. The active material is selected from electroluminescent materials. Support for this can be found at page 3, lines 1-7, page 7, lines 14-17, and page 12, lines 26-29 of the Specification. No new matter is introduced.

Claim Rejections - 35 U.S.C. § 102

Functional Terminology Should be Considered in Weighing Novelty Against References

The Office Action alleges that the functional terminology, "for depositing an active material on to a surface" is given no patentable weight, and goes on to say that unless the functional language "results in a structural difference between the claimed invention and the prior art" the functional language does not patentably distinguish the claimed subject matter over the prior art. Applicants respectfully traverse this formulation and respectfully assert that the rule is neither this narrow nor properly stated in precisely this terminology. The statement of the general rule as given in the Office Action may be correctly applied to means-plus-function elements in claims, but the functional language in the claims under examination are not means-plus-function elements. See MPEP § 2114.

Rather, MPEP § 2173.05(g) is on point. This portion of the MPEP states that the Examiner is required to consider a claim element or limitation stated in functional terms and give such element or limitation the same consideration as would be given to an element stated in any other terminology:

"A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the

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pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. >In *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), the court noted that the claim term "operatively connected" is "a general descriptive claim term frequently used in patent drafting to reflect a functional relationship between claimed components," that is, the term "means the claimed components must be connected in a way to perform a designated function." "In the absence of modifiers, general descriptive terms are typically construed as having their full meaning." *Id.* at 1118, 72 USPQ2d at 1006. In the patent claim at issue, "subject to any clear and unmistakable disavowal of claim scope, the term 'operatively connected' takes the full breath of its ordinary meaning, i.e., 'said tube [is] operatively connected to said cap' when the tube and cap are arranged in a manner capable of performing the function of filtering." *Id.* at 1120, 72 USPQ2d at 1008.<"

In a case recited in the MPEP, the CCPA held:

"It was held that the limitation used to define a radical on a chemical compound as 'incapable of forming a dye with said oxidizing developing agent' although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971)."

There is ample authority establishing that functional limitations are appropriate in claims and should be considered and afforded patentable weight by Examiner in considering whether a reference anticipates the claims under review. Functional limitations are to be given patentable weight even if the functional limitations are the only limitations that distinguish claims under review over the prior art. In the present case, there has been no rejection of the functional language under 35 U.S.C. § 112. Applicants respectfully submit that the functional language in the claims under review (i) is an appropriate limitation in that it sets boundaries on the patent protection sought, (ii) the boundaries are definite, and (iii) the limitation would be accessible to and understood by one with skill in the pertinent art. In other words, the functional limitation in the present claims is that the composition is useful for depositing an active material onto a surface.

For these reasons, Applicants respectfully submit that the functional terminology is proper and appropriate, that there is imparted patentable distinction over the prior art, and that the functional terminology should be considered and given patentable weight.

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(1) Babb et al., U.S. Patent No. 5,730,992

Claims 15 and 24-26 stand rejected under 35. U.S.C. § 102(b) as being anticipated by Babb.

The Examiner has pointed to a coating composition comprising (a) a compound having Formula I of Babb, (b) barium ferrite, iron oxide, or titania, and (c) a solvent. Applicants respectfully submit that this is not the same as Applicants' liquid composition as recited in Claim 15, as amended. Babb does not disclose or suggest a composition including electroluminescent materials. Rather, Babb is concerned with a laminate including a layer comprising a polymer with more than one perfluorocyclobutane group (Abstract) where the perfluorocyclobutane-containing polymers impart resistance to various kinds of environmental degradation.

The Office Action appears to rely on a finding that the prior art composition is "either the same or substantially the same as that claimed by the applicants." Page 4, first full paragraph. As noted above, there are no electroluminescent materials taught or fairly suggested in Babb. There is no showing, for example, in either Babb or the Office Action that polymers containing perfluorocyclobutane groups in their backbones are electroluminescent materials. As to the solvent, several are identified in Babb, at Col. 15, lines 12-24, including xylene, mesitylene, and toluene, chlorobenzene, chloromethane, and various polar solvents. The claimed liquid medium has a fluorinated group R_f linked to O, and R and X substituents, that are optional if m and n are both 0, otherwise, one or both may be required. This is not shown to be the same as the liquid medium claimed, there is merely a conclusory statement to the effect that chemical substances that have identical composition cannot have mutually exclusive properties. Since the compositions under review are not identical, this statement carries no weight for supporting this rejection.

Applicants respectfully submit that each and every limitation of independent Claim 15 has not been met by the reference, and therefore the reference does not anticipate Claim 15 or the claims dependent thereon. Applicants respectfully request that this rejection be withdrawn.

(2) Poetsch et al., U.S. Patent 5,196,140

Claims 15, 23-26, and 30-32 stand as rejected under 35 U.S.C. § 102(b) as being anticipated by Poetsch.

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Poetsch discloses a liquid crystal display having a dielectric which is a fluorinated compound. Applicants respectfully submit that this is not the same as Applicants' liquid composition as recited in independent Claims 15 and 23, as amended. Poetsch does not disclose or suggest a composition including electroluminescent materials.

Applicants respectfully submit that each and every limitation of independent Claims 15 and 23 have not been met by the reference, and therefore the reference does not anticipate Claims 15, 23, or the claims dependent thereon. Applicants respectfully request that this rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 103

(1) Babb et al., U.S. Patent No. 5,730,992

Claims 15 and 24-26 stand rejected under 35 U.S.C. § 103(a) as being obvious over Babb.

Applicants respectfully submit that there is no teaching or suggestion in Babb of solvent compositions including electroluminescent materials, as recited in Applicants' amended Claim 15. Applicants request that this rejection be withdrawn for independent Claim 15, and the claims dependent thereon.

(2) Poetsch et al., U.S. Patent 5,196,140

Claims 15 and 22-32 stand as rejected under 35 U.S.C. § 103(a) as being obvious over Poetsch.

Applicants respectfully submit that there is no teaching or suggestion in Poetsch of solvent compositions including electroluminescent materials, as recited in Applicants' amended Claims 15, 22, and 23. Applicants request that this rejection be withdrawn for independent Claims 15, 22, and 23, and the claims dependent thereon.


CONCLUSION

In view of the foregoing claim amendments and remarks, Applicants respectfully submit that the above referenced application is in condition for allowance and a notice of allowance is earnestly requested, for Claims 15 and 22-32.

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Should there be any questions about the content of this paper or the status of the application, the Examiner is invited to call the undersigned at the telephone number listed below.

Respectfully submitted,


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